

REMARKS

By this amendment, claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 are pending, in which claim 35 is amended to correct a discovered informality. No new matter is introduced.

The Office Action mailed February 15, 2007 rejected claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Specifically, the Examiner argues, using independent claim 1 as exemplary, that the limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable" is not enabled by the specification. The Examiner cites ¶41, lines 9-10, of the specification, regarding objects that have a time-to-live being cacheable, and concludes therefrom that since a cacheable object would never be marked as "uncacheable," "there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria." Further, the Examiner states, "[b]ased on ¶41 of the specification, it appears that these may be alternative criteria for forwarding, rather than complimentary criteria, but the current claim language does not capture such a relationship" (page 3 of the Office Action).

Applicants respectfully traverse the Examiner's rejection based on the enablement clause of 35 U.S.C. § 112.

It is basic patent law that, in order to satisfy the first paragraph of 35 U.S.C. § 112, the specification must teach those skilled in the art how to make and use the claimed invention without undue experimentation. If the Examiner presents a reasonable basis for challenging the sufficiency of disclosure, then the burden shifts to Applicants to show that the specification does, in fact, present an enabling disclosure. In the present case, the Examiner's challenge is not reasonable because reference to ¶41 of the specification clearly presents the flaw in the Examiner's position.

This paragraph explains the forwarding criteria to be (1) object size and (2) "cacheability." It is explained that an upstream server may only forward objects of a predetermined size or smaller, so that large objects are not sent to the downstream server. This is in accordance with the idea of preserving bandwidth. Additionally, if the embedded object is marked uncacheable, then the object may be forwarded to the downstream server which, by definition, will not have the object stored therein. As

disclosed, the upstream server may be configured to forward every retrieved embedded object, if bandwidth is not a major concern. Or, the upstream server may apply configurable rules to decide which objects to forward. ¶41 then gives an example: The upstream server “may examine the HTTP headers of the objects and forward objects which have a short time to live since such objects, while cacheable, are less likely to still be fresh in the downstream server cache.” Thus, as disclosed in ¶41, and set forth in claim 1, the upstream server is “to forward the object based on a predetermined criteria relating to the object.” The claim then goes on to recite **specific criteria, including** time-to-live of the object and the object being marked as uncacheable. Thus, as explained in the specification, and as claimed, time-to-live of the object and the object being marked as uncacheable are two, **unrelated, examples** of the type of criteria relating to the object upon which forwarding the object is based.

For example, in describing a kitchen drawer which holds types of utensils, “including forks, knives, and spoons,” the forks and knives and spoons need not all be in the drawer and the drawer may also hold other types of utensils, and including “and” in “forks, knives, **and** spoons” does not mean that **all** these utensils must be present. It means merely that a list of the types of utensils that may be in the drawer includes “forks, knives, and spoons.”

Thus, contrary to the Examiner’s interpretation, the claim language, “time-to-live of the object and the object being marked as uncacheable,” does not mean or require that both of these criteria must be present in order for an object to be forwarded to the downstream proxy server. Rather, these are merely but two **examples** of the type of criteria that might cause an object to be forwarded to the downstream proxy server. One may consider these examples to be alternative in nature, rather than combined, but they are not so much alternatives as they are **examples** of criteria that may cause the forwarding of an object.

The Examiner appears to recognize, at page 4 of the Office Action, that at least when read in the alternative light, the rejection of the claims under the first paragraph of 35 U.S.C. § 112 cannot stand and the Examiner is therefore requested to withdraw this rejection.

The Examiner further indicates, at page 4 of the Office Action, that if the examples in the claims are interpreted as alternatives, then the rejection set forth in the Office Action of 7/28/2006 is “maintained.”

Applicants strenuously object to this “back-door” rejection. If the Examiner sought to maintain some previous rejection of the claims, the Examiner could have, and should have, included said

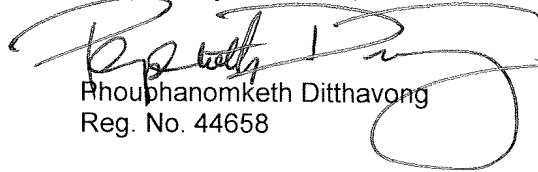
rejection(s) in the current Office Action, with a full explanation of the rejection, so that Applicants would have a full understanding and appreciation of the current rejection of the claims. But, by merely stating that if a certain interpretation of the claims should prevail, "the rejections set forth in the Office action of 7/28/2006 should be considered maintained," Applicants have not been given fair notice of the outstanding rejection(s). At best, the Examiner is engaging in "piecemeal prosecution," seemingly dropping one set of rejections (by not repeating them in the new Office Action), offering a new ground of rejection, and then trying to preserve everything by stating, in essence, that "if you don't like my new rejection, then consider the old rejection to be reinstated." This is highly unfair and prejudicial to Applicants who are now unsure of the current status of the present application and of the current outstanding rejections. When the Examiner states that if the claim language is interpreted in a certain manner, "the rejections set forth in the Office action of 7/28/2006 should be considered maintained," is the Examiner referring to **all** of the previous rejections, including the written description rejection, or only to the rejection(s) based on prior art?

The Office Action is unclear. If, indeed, all of the rejections are maintained, it would appear inconsistent since the written description rejection is based on the same reasoning applied in the enablement rejection which would be overcome if the old rejection is to be "maintained." If it is only the prior art rejections which are being "maintained," or reinstated, is it **all** of the prior art rejections or only some of them. Since the time of those rejections, Applicants have amended the claims and presented arguments, in the response of October 30, 2006. If all, or any, of the rejections set forth in the Office Action of 7/28/2006, are to be "maintained," then Applicants are entitled to a response to the amendment to the claims and to the arguments presented on October 30, 2006. In fact, the Examiner states that, in the Office action of February 15, 2007, "Applicant's arguments are moot in view of the new grounds of rejection." Yet, if the Examiner is attempting to "bootstrap" the old rejections into the newest Office Action, then Applicants' arguments are not "moot" and deserve a response.

For the reasons above, explaining how the enablement rejection has been overcome, Applicants truly believe that this case is now in condition for allowance. However, because of the inconsistency in, and confusing nature of, the Examiner's Office Action, if, for any reason, Applicants' good faith response does not place this case in condition for allowance, Applicants would hope that any such next Office Action would not be made Final.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration of this application is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (301) 601-7252 so that such issues may be resolved as expeditiously as possible. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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